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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,482	03/30/2004	Paula Olthoff	600.479US2	4796
21186 7590 01/05/2009 SCHWEGMAN, LUNDBERG & WOESSNER, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402				
EXAMINER				
BAUM, STUART F				
ART UNIT		PAPER NUMBER		
1638				
MAIL DATE		DELIVERY MODE		
01/05/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/813,482

Applicant(s)

OLHOFT ET AL.

Examiner

STUART F. BAUM

Art Unit

1638

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-64, 67, 68 and 71-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 57-64, 67, 68 and 71-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The amendment filed 9/17/2008 has been entered.
2. Claims 57-64, 67-68 and 71-78 are pending.
Claims 1-56, 65-66 and 69-70 have been canceled.
Claims 77 and 78 have been newly added and are drawn to the elected invention.
3. Claims 57-64, 67-68 and 71-78 are examined in the present office action.
4. Rejections and objections not set forth below are withdrawn.
5. The text of those sections of Title 35, U.S. Code not included in this office action can be found in a prior office action.

Enablement

6. Claims 57-61, 63-64, 67-68, 71-76 remain rejected and new claims 77-78 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This rejection is maintained for the reasons of record set forth in the Official action mailed 6/17/2008. Applicant's arguments filed 9/17/2008 have been fully considered but they are not persuasive.

Applicants contend that Agrobacterium-mediated transformation is used to transform a broad range of plants as evidenced by the teachings of Hansen et al (page 8 of Remarks, 5th and 6th paragraphs).

The Office contends that Applicants have not taught transformation protocols for the full breadth of the claims. Transformation protocols include not only a DNA delivery system, e.g., *Agrobacterium*, but also media constituents and a disclosure about the target explant, i.e., which tissue and at what stage of development it is competent for transformation and regeneration. Therefore, given the state-of-the-art as recited in the previous office action, the lack of disclosure, and the breadth of the claims, undue trial and error experimentation would be required by one of skill in the art to practice the claimed invention.

Claim Rejections - 35 USC § 103

7. Claims 57-64, 67, 71-73 and 75-76 remain rejected and new claims 77-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enriquez-Obregon et al (1997, *Biotechnologia Aplicada* 14(3):169-174) taken with Hansen et al (1999, *Trends in Plant Science* 4(6):226-231). This rejection is maintained for the reasons of record set forth in the Official action mailed 6/17/2008. Applicant's arguments filed 9/17/2008 have been fully considered but they are not persuasive.

Applicants contend it is unclear from the disclosure in Enriquez-Obregon et al whether cysteine alone in the solid medium and at what concentration, would result in enhanced stable transformation (page 10 of Remarks, 8th paragraph).

The Office contends that Enriquez-Obregon et al teach 40 mg/L cysteine and that it would be obvious to one of skill in the art to modulate cysteine concentration, especially since the claimed amount is only 10 mg/L different from that used by Enriquez-Obregon et al and

since cysteine was found effective for Enriquez-Obregon et al and since Applicants' claims are drawn to any plant and any explant source. The recitation "enhanced stable transformation" carries no weight because it lacks a comparative basis.

Applicants request a reconsideration of the 132 Declaration of Dr. Olhoft. Dr. Olhoft contends there is a balance between plant cell viability and agent toxicity (page 11 of Remarks, 1st full paragraph).

The Office contends that Dr. Olhoft does not present any published data regarding cysteine concentration on cell viability and transformation. Dr. Olhoft's contention that there would be no reason to try higher amounts of any agents is merely his opinion. The Office contends the claimed invention would be obvious over the stated prior art as stated in the previous office action.

8. No claims are allowed.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stuart F. Baum whose telephone number is 571-272-0792. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached at 571-272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Stuart F. Baum/
Stuart F. Baum Ph.D.
Primary Examiner
Art Unit 1638
December 31, 2008